UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,347	03/12/2004	Michael Ian McGregor	RPS920040005US1	9907

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _12 March 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _12 March 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _March 12, 2004_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-23 are pending in this application.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4.   With respect to claim 1, an "apparatus for automatically populating an interactive messaging contact list" is being recited, however it appears that the apparatus would be reasonably interpreted by one of ordinary skill in the art as software, per se. The apparatus is comprised of "retrieval," "validation," and "insertion modules"; description of such a module is provided in the specification as being, "a module of executable code," (Paragraph [0022], line 1) leaving no other reasonable interpretation of any such module as anything other than software.

5.   Claims 2-6 fail to resolve the deficiencies of claim 1, since the only elements recited in these claims are in relation to a modification of the retrieval module. There is no further embodiment for such a module that would necessitate the apparatus to be anything other than software.

6.   Claim 7 fail to resolve the deficiencies of claim 1, since the only elements recited in these claims are in relation to a modification of the insertion module. There is no

further embodiment for such a module that would necessitate apparatus to be anything

other than software.

7.   With respect to claim 8, a "method for automatically populating an interactive

messaging contact list" is being recited, however it appears that the method would be

reasonably interpreted by one of ordinary skill in the art as software, per se. The

method is comprised of "retrieving," "validating," and "adding contact information" to an

"interactive messaging contact list"; description of such a method is provided in the

specification by use of a flow chart (Figure 3) and offers no further embodiment that

would necessitate such a method as being anything other than software.

8.   Claims 9-15 fail to resolve the deficiencies of claim 8, since the only elements

recited in these claims are in relation to modifications of the method whereby actions

are caused for searching/parsing data, and prompting/receiving input from a user.

There is no further embodiment for such a module that would necessitate it be anything

other than software.

9.   With respect to claim 16, an "apparatus for automatically populating an

interactive messaging contact list" is being recited, however it appears that the

apparatus would be reasonably interpreted by one of ordinary skill in the art as

software, per se. The method is comprised of "means for retrieving," "validating," and

"adding contact information" to an "interactive messaging contact list"; description of

such an apparatus is provided in the specification by use of a block diagram (Figure 2)

and offers no further embodiment that would necessitate such a method as being

anything other than software.

Claim Rejections - 35 USC § 112

10.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

11.   Claim 4-6, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

12.   Claims 4-5 are rejected, both claims refer to the "the data source," there is

insufficient antecedent basis for this reference in the original claim of claim 1. It is

believed that the, "plurality of contact sources" serves the as the reference of the

aforementioned "data sources," and should be referenced as such.

13.   Claim 6 is rejected, the ""retrieval module" is not substantiated in the specification

to provide the functionality claimed. It is believed that the retrieval module is

erroneously referenced in the claim, in place of properly referencing the validation

module, thus being consistent with the functionality of each module as set forth in the

specification (paragraph [0031]).

14.   Claim 19 is objected to, the phrase, "enable a user selectively insert," is unclear.

It is recommended that the phrase be amended to read, "enable a user *to* selectively

insert."

Claim Rejections - 35 USC § 102

15.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16.   Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ring et

al. (Pat. No, 7,080,104), hereinafter Ring.

17.   With respect to claim 1, Ring discloses an apparatus for automatically populating

an interactive messaging contact list (column 3, lines 36-59), the apparatus comprising:

a retrieval module configured to retrieve contact information corresponding to online

users from a plurality of contact sources associated with a user including at least one

electronic address book (column 19, lines 4-10); a validation module configured to

validate the contact information on a messaging server to provide validated contact

information (column 19, lines 61-67; column 20, lines 1-2); and an insertion module

configured to add the validated contact information to an interactive messaging contact

list (column 19, lines 4-10).

18.   With respect to claim 2, Ring discloses the apparatus of claim 1, wherein the

retrieval module is further configured to search storage devices and other data

repositories for a known address book format (column 10, lines 4-19).

19.   With respect to claim 3, Ring discloses the apparatus of claim 2, wherein the

known address book format is selected from the group consisting of a Lotus Notes

format, an Eudora Mail format, and a Microsoft Outlook format (column 8, lines 1-6).

20.   With respect to claim 4, Ring discloses the apparatus of claim 1, wherein the

retrieval module is further configured to extract contact information by parsing an email

address retrieved from the data sources (column 15, lines 37-53).

21.   With respect to claim 5, Ring discloses the apparatus of claim 1, wherein the

retrieval module is further configured to extract contact information by parsing a first and

last name retrieved from the data sources (column 15, lines 37-53).

22.   With respect to claim 6, Ring discloses the apparatus of claim 1, wherein the

retrieval module is further configured to prompt a user to resolve conflicts in contact

information (column 19, lines 61-67; column 20, lines 1-2).

23.   With respect to claim 7, Ring discloses the apparatus of claim 1, wherein the

insertion module is further configured to enable a user to selectively insert contacts into

the interactive messaging contact list (column 8, lines 1-29).

24.   With respect to claim 8, Ring discloses the method for automatically populating

an interactive messaging contact list (column 3, lines 36-59), the method comprising:

retrieving contact information corresponding to online users associated with a user from

a plurality of contact sources including at least one electronic address book (column 19,

lines 4-10); validating the contact information on a messaging server to provide

validated contact information (column 19, lines 61-67; column 20, lines 1-2); and adding

the validated contact information to an interactive messaging contact list (column 19,

lines 4-10).

25.   With respect to claim 9, Ring discloses the method of claim 8, further comprising

searching storage devices and other data repositories for a known address book format

(column 10, lines 4-19).

26.   The method of claim 10, wherein the known address book format is selected

from the group consisting of a Lotus Notes format, an Eudora Mail format, and a

Microsoft Outlook format (column 8, lines 1-6).

27.   With respect to claim 11, Ring discloses the method of claim 8, further

comprising parsing the contact information (column 15, lines 37-53).

28.   With respect to claim 12, Ring discloses the method of claim 11, wherein parsing

the contact information comprises resolving a first and last name (column 15, lines 37-

53).

29.   With respect to claim 13, Ring discloses the method of claim 8, further

comprising prompting a user to resolve conflicts in the contact information (column 19,

lines 61-67; column 20, lines 1-2).

30.   With respect to claim 14, Ring discloses the method of claim 8, further

comprising enabling a user to selectively insert contacts into the interactive messaging

contact list (column 8, lines 1-17).

31.   With respect to claim 15, Ring discloses the method of claim 8, further

comprising generating a confirmation request for an inserted contact (column 19, lines

61-67; column 20, lines 1-2).

32.   With respect to claim 16, Ring discloses an apparatus for automatically
populating an interactive messaging contact list (column 3, lines 36-59), the apparatus
comprising: means for retrieving contact information corresponding to online users
associated with a user from a plurality of contact sources including at least one
electronic address book (column 19, lines 4-10); means for validating the contact
information on a messaging server to provide validated contact information (column 19,
lines 61-67; column 20, lines 1-2); and means for adding the validated contact
information to an interactive messaging contact list (column 19, lines 4-10).

33.   With respect to claim 17, Ring discloses the system for automatically populating
an interactive messaging contact list (column 3, lines 36-59), the system comprising: a
client computer configured to retrieve contact information corresponding to online users
associated with a user from a plurality of contact sources including at least one
electronic address book (column 19, lines 4-10); a messaging server configured to
validate the contact information (column 19, lines 61-67; column 20, lines 1-2); and the
client computer further configured to add the validated contact information to an
interactive messaging contact list (column 19, lines 4-10).

34.   With respect to claim 18, Ring discloses the system of claim 17, wherein the
client computer is further configured to prompt a user to resolve conflicts in contact
information (column 19, lines 61-67; column 20, lines 1-2).

35.   With respect to claim 19, Ring discloses the system of claim 17, wherein the
client computer is further configured to enable a user selectively insert contacts into the
interactive messaging contact list (column 8; lines 1-17).

36.   With respect to claim 20, Ring discloses a computer readable storage medium

comprising computer readable program code configured to carry out a method for

automatically populating an interactive messaging contact list (column 3, lines 36-59),

the method comprising: retrieving contact information corresponding to online users

associated with a user from a plurality of contact sources including at least one

electronic address book (column 19, lines 4-10); validating the contact information on a

messaging server to provide validated contact information (column 19, lines 61-67;

column 20, lines 1-2); and adding the validated contact information to an interactive

messaging contact list (column 19, lines 4-10).

37.   With respect to claim 21, Ring discloses the computer readable storage medium

of claim 20, wherein the method further comprises prompting a user to resolve conflicts

in contact information (column 19, lines 61-67; column 20, lines 1-2).

38.   With respect to claim 22, Ring discloses the computer readable storage medium

of claim 20, wherein the method further comprises enabling a user to selectively insert

contacts into the interactive messaging contact list (column 8; lines 1-17).

39.   With respect to claim 23, Ring discloses the computer readable storage medium

of claim 20, wherein the method further comprises generating a confirmation request for

an inserted contact (column 19, lines 61-67; column 20, lines 1-2).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rubin Blake whose telephone number is (571) 270-

3802. The examiner can normally be reached on M-R: 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nabil El-Hady can be reached on (571) 272-3963. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

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BR
10/25/2007

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